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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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THIS-0007

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HM12/0113

EXAMINER

DELSA, B

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

01/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/076,404

Applicant(s)

Ecker et al.

Examiner

Bennett Celsa

Group Art Unit

1627

Responsive to communication(s) filed on _____

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

* ☒ NOTICE TO COMPLY: SETTING 1mth extendable time period for response

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1627

DETAILED ACTION: SUPPLEMENTAL ELECTION / RESTRICTION

Claims 1-20 are currently pending.

NOTE: CHANGE OF APPLICATION LOCATION TO *ART UNIT 1627*.

Sequence Rules: NOTICE TO COMPLY

The present application must comply with the sequence rules since the application contains numerous instances (e.g. See Figures; page 63; and examples) of nucleotides of 10 or more units. *Each nucleotide* of 10 or more requires its own unique identifier.

It is noted that applicant previously attempted to submit a computer readable form (CRF) and corresponding paper copy to which was assigned the incorrect serial number.

Applicant will need to provide a new CRF, corresponding paper copy and new matter statement. See attached NOTICE TO COMPLY LETTER.

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Election/Restriction

1. Applicant's election with traverse of Group I (claims 1-10; 17-20) in Paper No.11 is acknowledged. Upon further consideration, the following election of a species of biomolecular target is required in order to facilitate search.

Election/Restriction

2. This application contains claims (e.g. claims 1-10; 17-20) directed to the following patentably distinct species of the claimed invention: methods directed to "a wide variety" of biomolecular targets (e.g. see specification on page 22) including (but not limited to) the following generic categories with corresponding classifications::

- a. Peptides (or proteins): classified 530/300,350
- b. Oligosaccharides: 536/1.11
- c. Nucleic acids (e.g. DNA, RNA, DNA/RNA hybrids): 536/23.1+
- d. Glycopeptides: 530/322
- e. Antibodies: 530/387.1
- f. Receptors: 435/7.8
- g. Enzymes: 435/183

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The above categories of compounds (e.g. a-e) encompass species which have totally different structure, physicochemical properties; and are capable of separate manufacture and/or use. Additionally these different categories of compounds have acquired a separate status in the art as shown by their different classification; different searches (e.g. manual and computer) classification, structure and/or bibliographic ; and because of their separate status in the art due to their recognized divergent subject matter. Accordingly, for all of the aforementioned reasons, the election of a species for examination purposes as indicated is proper

Applicant is required under 35 U.S.C. 121 to elect a single disclosed category of species (e.g. from a-g above) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 6 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a *listing of all claims readable thereon*, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Adams (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

Bennett Celsa
January 12, 2000

BENNETT CELSA
PRIMARY EXAMINER